



1 for A75/2615
PATENT
Atty. Docket No.: FUSI-02200

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Onyon, et al.

Serial No.: 10/789,816

Filed: February 27, 2004

For: **WIRELESS TELEPHONE DATA
BACKUP SYSTEM**

) Group Art Unit: 2617
)
)

) Examiner: Rampuria, Sharad K..
)

) **TRANSMITTAL LETTER**
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)
)

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Commissioner for Patents
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Sir:

An Appeal Brief is enclosed for filing with the U.S. Patent and Trademark Office. Additionally, a check in the amount of \$255.00 to cover the cost of filing the Appeal Brief is also enclosed.

The Commissioner is authorized to charge any additional fee or credit any overpayment to our Deposit Account No. 08-1275. **An originally executed duplicate of this transmittal is enclosed for this purpose.**

Respectfully submitted,

HAVERSTOCK & OWENS LLP

Dated: 3-14-08

By: Thomas B. Haverstock

Thomas B. Haverstock
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Attorneys for Applicant(s)



PATENT
Attorney Docket No.: FUSI-02200

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	Group Art Unit: 2617
Onyon, et al.)	Examiner: Rampuria, Sharad K
Serial No.: 10/789,816)	APPEAL BRIEF
Filed: February 27, 2004)	162 North Wolfe Road
For: WIRELESS TELEPHONE DATA)	Sunnyvale, California 94086
BACKUP SYSTEM)	(408) 530-9700
)	Customer No.: 28960

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Sir:

In furtherance of the Applicants' Notice of Appeal filed on January 17, 2008, this Appeal Brief is submitted. This Appeal Brief is submitted in support of the Applicants' Notice of Appeal, and further pursuant to the rejection mailed on January 10, 2008, in which Claims 1-29, 52-60 and 82-93 were rejected. The Applicants submit this Appeal Brief to the Board of Patent Appeals and Interferences in compliance with the requirements of 37 C.F.R. § 41.37, as stated in *Rules of Practice Before the Board of Patent Appeals and Interferences (Final Rule)*, 69 Fed. Reg. 49959 (August 12, 2004). The Applicants contend that the rejections of Claims 1-29, 52-60 and 82-93 in this proceeding are in error, were previously overcome and are overcome again by this appeal.

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Date:

3/14/08

By:

I. REAL PARTIES IN INTEREST

As the assignee of the entire right, title, and interest in the above-captioned patent application, the real party in interest in this appeal, is:

FusionOne, Inc.
1 Almaden Boulevard
San Jose, CA 95113

per the assignment document recorded on November 15, 2005.

II. RELATED APPEALS AND INTERFERENCES

The Applicants are not aware of any other appeals or interferences related to the present application.

III. STATUS OF THE CLAIMS

Claims 1-29, 52-60 and 82-93 are pending in this case. Claims 1-5, 14-17, 20-29, 52, 55-60, 82-86, 92 and 93 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,757,698 to McBride et al. ("McBride", a copy of which is attached as Exhibit A) in view of U.S. Patent Publ. No. 2005/0131990 to Jewell ("Jewell", a copy of which is attached as Exhibit B). Claims 6-13, 53, 54 and 87-89 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McBride and Jewell further in view of U.S. Patent No. 6,396,482 to Griffin et al. ("Griffin", a copy of which is attached as Exhibit C). Claims 18, 19, 90 and 91 stand rejected under 35 U.S.C. §103(a) as being unpatentable over McBride and Jewell in view of U.S. Pat. Publ. No. 2004/0192260 to Sugimoto et al. ("Sugimoto", a copy of which is attached as Exhibit D).

IV. STATUS OF THE AMENDMENTS FILED AFTER FINAL REJECTION

No amendments have been filed after the Office Action mailed on January 10, 2008.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The invention disclosed in the present application number 10/789,816 is directed to a system for and method of backing up and restoring data on a wireless telephone having a data store containing a user's personal information.

The elements of Claim 1, directed to one embodiment of the present invention, are described in the Specification at page 8, paragraph 0035 through page 18, paragraph 0060 and accompanying Figures 1-5E. The method implemented by a processing device on a wireless telephone (300) for backing up personal information stored in the wireless telephone (300), comprises presenting a back-up system user account set-up interface (202, 204, 206, 208, 210) on a user interface on the wireless phone (300), the set-up interface enabling establishment of a back-up service account, and the set-up interface including a display, one or more alphanumerical buttons and one or more soft buttons (302, 304), different than the alphanumerical buttons, on the wireless phone (300), the function of the one or more soft buttons (302, 304) on the wireless phone (300) changing, under control of a software application agent (110) on the wireless phone (300), depending on the content displayed on the display screen, presenting a backup scheduling interface (212) to the user interface on the wireless phone (300), the backup scheduling interface accepting user input on a backup schedule, and the backup scheduling interface including a display, one or more alphanumerical buttons and one or more soft buttons (302, 304), different than the alphanumerical buttons, on the wireless phone (300), the function of the one or more soft buttons (302, 304) on the wireless phone (300) changing, under control of a software application agent (110) on the wireless phone (300), depending on the content displayed on the display screen and presenting a restore information interface (402, 404, 406, 408, 410) on the user interface on the wireless phone (300), the restore interface enabling a user to retrieve backup information to a data store on the wireless phone (300), and the restore information interface including a display, one or more alphanumerical buttons and one or more soft buttons (302, 304), different than the alphanumerical buttons, on the wireless phone (300), the function of the one or more soft buttons (302, 304) on the wireless phone (300) changing, under control of a software application agent (110) on the wireless phone (300), depending on the content displayed on the display screen.

The elements of Claim 20 directed to one embodiment of the present invention, are described in the Specification at page 8, paragraph 0035 through page 18, paragraph 0060 and accompanying Figures 1-5E. The method of storing personal information in a wireless telephone (300) in a backup storage database, comprises providing a phone agent (110) including

instructions operable by a processor in the phone (300) to implement an automated phone data transmission method capable of regularly transmitting changes to a backup store (510) via a communications link (150), and a restore method retrieving backup information to a data store on the phone (300), the agent (110) including a backup service sign-up interface (202, 204, 206, 208, 210), a backup method scheduling interface (212) and a restore interface (402, 404, 406, 408, 410), calling the restore method, all provided to a user interface on the phone (300), the user interface on the phone (300) including a display and one or more buttons on the phone (302, 304), and responsive to user entry at the restore interface of said agent (110), providing changes from the backup store (510) to the wireless telephone (300).

The elements of Claim 52 directed to one embodiment of the present invention, are described in the Specification at page 8, paragraph 0035 through page 18, paragraph 0060 and accompanying Figures 1-5E. The application for storing personal information in a wireless telephone (300) having a user interface and having a data store, to a backup system (160), comprises an automated user account creation method (202, 204, 206, 208, 210) initiated by a user via a user interface on a wireless telephone (300), the creation method (202, 204, 206, 208, 210) accessing the backup system (160) using a unique identifier for the user to create a user account on the backup system (160), an automated backup method transmitting changes to the backup system at user defined intervals and a restore method (402, 404, 406, 408, 410) called by the user through a restore interface (402, 404, 406, 408, 410) presented on the user interface of the phone (300), the restore method (402, 404, 406, 408, 410) providing user data to a phone (300).

The elements of Claim 82 directed to one embodiment of the present invention, are described in the Specification at page 8, paragraph 0035 through page 18, paragraph 0060 and accompanying Figures 1-5E. The user interface implemented by a processing device on a telephone for backing up personal information stored in the wireless telephone (300), comprises an account set-up interface (202, 204, 206, 208, 210) on the wireless phone (300) enabling establishment of a back-up service account, a scheduling interface (212) on the wireless phone (300) allowing a user to manually set up a schedule for backing up data on the wireless phone (300), the scheduling interface (212) including: a display on the wireless phone (300), alphanumeric buttons on the wireless phone (300), soft buttons (302, 304) on the wireless phone (300), different than the alphanumeric buttons, the function of the soft buttons (302, 304) changing depending on what is displayed on the display, and a software application agent (110) on the wireless phone (300) for: 1) controlling what is displayed on the display, 2) controlling the

function of the soft buttons (302, 304), and 3) setting up a back-up schedule when information is sent to a back-up store (510) based on information manually entered into the scheduling interface and a restore information interface (402, 404, 406, 408, 410) enabling a user to retrieve backup information to a data store on the wireless phone (300).

The elements of Claim 92 directed to one embodiment of the present invention, are described in the Specification at page 8, paragraph 0035 through page 18, paragraph 0060 and accompanying Figures 1-5E. The user interface implemented by a processing device on a wireless telephone (300) for backing up personal information stored in the wireless telephone (300), comprises an account set-up interface (202, 204, 206, 208, 210) on the wireless phone (300) enabling establishment of a back-up service account, a scheduling interface (212) on the wireless phone (300) allowing a user to manually set up a schedule for backing up data on the wireless phone (300), a restore information interface (402, 404, 406, 408, 410) enabling a user to retrieve backup information to a data store on the wireless phone (300), one or more of the account-setup interface, scheduling interface and the restore information interface (402, 404, 406, 408, 410) including: a display on the wireless phone (300), alphanumeric buttons on the wireless phone (300), soft buttons (302, 304) on the wireless phone (300), different than the alphanumeric buttons, the function of the soft buttons (302, 304) changing depending on what is displayed on the display, and a software application agent (110) on the wireless phone (300) for: 1) controlling what is displayed on the display, and 2) variably setting the function of the soft buttons (302, 304).

The elements of Claim 93 directed to one embodiment of the present invention, are described in the Specification at page 8, paragraph 0035 through page 18, paragraph 0060 and accompanying Figures 1-5E. The user interface implemented by a processing device on a wireless telephone (300) for backing up personal information stored in the wireless telephone (300), comprises an account set-up interface (202, 204, 206, 208, 210) on the wireless phone (300) enabling establishment of a back-up service account, a scheduling interface (212) on the wireless phone (300) allowing a user to manually set up a schedule for backing up data on the wireless phone (300) and a restore information interface enabling a user to retrieve backup information to a data store on the wireless phone (300), one or more of the account-setup interface (202, 204, 206, 208, 210), scheduling interface (212) and the restore information interface (402, 404, 406, 408, 410) including a display on the wireless phone (300), the display displaying one or more of words and icons, a user interacting with the user interface by selecting one or more of the words and icons on the display and a software application agent (110) on the

wireless phone (300) for: 1) controlling what is displayed on the display, and 2) controlling backup of personal information based on the selection of one or more of the words and icons on the display.

VI. GROUND OF REJECTION AND OTHER MATTERS TO BE REVIEWED ON APPEAL

The following issues are presented in this Appeal Brief for review by the Board of Patent Appeals and Interferences:

1. Whether Claims 1-5, 14-17, 20-29, 52, 55-60, 82-86, 92 and 93 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over McBride in view of Jewell.
2. Whether Claims 6-13, 53, 54 and 87-89 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over McBride and Jewell further in view of Griffin.
3. Whether Claims 18, 19, 90 and 91 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over McBride and Jewell in view of Sugimoto.

VII. ARGUMENT

Grounds for Rejection

Within the Office Action, Claims 1-5, 14-17, 20-29, 52, 55-60, 82-86, 92 and 93 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over McBride in view of Jewell.

Outline of Arguments

In the discussion that follows, the Applicants first present a time line of prosecution to illustrate several issues that occurred during the prosecution of the present application. Then, the Applicants discuss the teachings of McBride, the teachings of Jewell and the teachings of the combination of McBride and Jewell. As will be discussed in detail below, the combination of McBride and Jewell is not proper and even if considered proper, the combination does not teach a wireless phone with a restore interface.

1. Time line of prosecution.

When Haverstock & Owens became counsel for Assignee, FusionOne, the present application had previously been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. App. No. 2004/0235523 to Schrire et al. (hereinafter Schrire) in view of U.S. Pat. App. No. 2004/0193953 to Callahan et al. (hereinafter Callahan). A telephone interview on June 27, 2007, was held with Examiners Rampuria and Eng where it was clearly illustrated that the rejection was improper. After filing a response to the Office Action mailed May 7, 2007, which was the focus of the discussion in the telephone interview, the rejection was withdrawn.

However, new art was then found by Examiner Rampuria. Why this art was not presented previously for an efficient prosecution of the application is unknown. Although the claims had been modified slightly through amendments, the patentable aspects remained the same since the initial filing of the application. The reasoning for the new search provided to the Applicants was that an updated search needed to be done to see if new references became available. However, the reference found by this new search was McBride which was published on July 4, 2002 and issued on June 29, 2004, both dates well before any review of the present application began. This reference was hardly "new." The McBride reference was disclosed to Applicants via telephone, and it was pointed out over the phone that McBride clearly does not teach a restore interface.

Following that telephone conversation with Examiner Rampuria where it was made clear that McBride does not teach a restore interface, an Office Action was mailed on August 10, 2007, which included the present rejections based on McBride and Jewell. Jewell is another reference that was available well before the Examiner's initial search as it was published on June 16, 2005. Again, it is confusing and frustrating to Applicants that this rejection was not included in parallel with the initial rejection based on Schrire and Callahan; rather, the rejection based on McBride and Jewell was presented serially making prosecution of the application much longer. As is described in detail below, Jewell is based on a provisional filed before the present application, but the regular Jewell application was filed after the present invention and thus is not prior art. The Examiner initially based the rejection in the Office Action mailed August 10, 2007, improperly on the regular application which is not prior art. After yet another series of telephone conferences with the Examiner, the Examiner agreed that the regular application of Jewell is not prior art, and the provisional Jewell application does not teach a restore interface on a wireless phone nor does the combination of McBride and Jewell teach a restore interface on a wireless

phone. At this point, Examiner Rampuria agreed that the claimed invention was allowable over the combination of McBride and Jewell. The only request by the Examiner was for Claim 1 to be amended to include the word “wireless” before phone and Claims 30-51 to be canceled. Although Applicants disagreed with the need for these changes, to further prosecution, Applicants accepted the requested changes and prepared a response incorporating the amended claim and the canceled claims.

However, before the response was filed, the Examiner stated that even though he had just performed the search to find the McBride and Jewell references, he stated he needed to do yet another search in case anything else had become available. Again, the process was inefficient. Why the need for yet another search?

Examiner Rampuria called Applicants’ attorney with his new search results which included U.S. Patent No. 7,283,808 (published on July 25, 2002) and U.S. Patent App. Nos. 2004/0185877 (published on September 3, 2004) and 2003/0096600 (published on May 22, 2003). All were again available well before the initial search for the present application. Fortunately, via another telephone conference with Examiner Rampuria, it was explained to the Examiner that these three new references do not teach the claimed invention. Upon completion of this conversation, it was agreed that Applicants would file a response to the Office Action mailed August 10, 2007 including an amended Claim 1 with a “wireless” phone, and that Claims 30-51 would be canceled since the rejection was maintained against those claims. Examiner Rampuria stated that since the references, including the three newest ones, that he found do not teach the remaining claims of the claimed invention, he “would have to issue a notice of allowance.” Examiner Rampuria called Applicants a few days later requesting Claims 82, 92 and 93 to be amended to include a “wireless” phone as well. Though not necessary to distinguish over the references, this amendment was also agreed upon to further prosecution. It was agreed that the Examiner would amend the claims by Examiner’s amendment, and Applicants faxed amended Claims 82, 92 and 93 to assist the Examiner in making his amendment so that the claims would be allowable.

After receiving verbal assurances that the claims would be allowed, having canceled claims to ensure only allowable claims remained in the application, and after another 3 month delay, to Applicants’ amazement, yet another non-final Office Action was mailed on January 10, 2008, from which this Appeal is based. Applicants were informed that although Examiner Rampuria felt the claims are allowable, his supervisor, Mr. Eng disagreed. Therefore, Applicants have clearly shown that the remaining, amended claims are allowable over the prior art, to which

Examiner Rampuria agreed. Taking Examiner Rampuria at his word, it is only Supervisor Eng who has the lone position that the prior art teaches the claimed invention.

It is Applicants' reading of the United States Constitution, that patents and the United States Patent and Trademark Office are to promote invention and discovery in this country. Indeed, it appears that the United States Patent and Trademark Office should help inventors to obtain the broadest possible protection for inventions. Applicants submit this is not happening with this application.

2. McBride does not teach a restore interface on a wireless phone, and in fact, McBride teaches away from a restore interface on a wireless phone.

McBride teaches a data file mirroring application that monitors data files stored in a source directory for archiving to at least two other backup data storage locations. One of these backup data storage locations is on the Internet. The other may be a local data storage location, meaning a location that the host computer can access without using the Internet, such as a floppy drive, hard drive, high-density storage medium drive and so on. The user interface of the mirroring application flexibly allows the user to specify the source data to be backed up and the two or more backup data storage locations. [McBride, Abstract] However, as is recognized in the Office Action, McBride does not teach presenting a restore information interface on the user interface on the phone, the restore interface enabling a user to retrieve backup information to a data store on the phone. The only time McBride references "restore" is in a single paragraph in Thus, there is no restore interface on the target device and McBride teaches away from using a restore interface. Column 12, Lines 1-15. That paragraph teaches using convention computer file manipulation.. This point was agreed during more than one telephone interview and acknowledged in the Office Action. Furthermore, although McBride includes a paragraph and Figure 19 to generically state that the teachings in McBride are applicable to phones, considering the McBride patent in total, clearly McBride only provides sufficient teachings related to standard computers with removable media drives for restoring data. Figures 5-13, 18 and 20-29, which actually demonstrate implementation of the teachings of McBride, are only directed to standard computers and were not capable of being implemented on wireless phones in December 22, 2000, when McBride was filed. Removable media drives are similar to floppy drives and thus are completely incompatible with a wireless phone since a wireless phone would never have

nor be able to support a removable media drive. There is simply no reason for McBride to have a restore interface.

As is described below, impermissible hindsight is used to combine the McBride and Jewell, but impermissible hindsight is also being used to read more into McBride than what McBride actually teaches. McBride was filed December 22, 2000, over 7 years ago, or in terms of technology, eons ago. The mobile phones of December 22, 2000 do not have the capabilities of the phones today such as the iPhone which has an internal hard drive, wireless communication capabilities as well as cellular communication capabilities and many other features not remotely thought of in 2000. The mobile phones of December 22, 2000 were mainly used to input a phone number and dial that phone number, nothing more. The concepts of backing up data, restoring data and using interfaces to perform these tasks were not even close to being in existence. Clearly, the benefit of thinking about present day wireless phones and incorporating their features into what McBride teaches has occurred, which is improper.

Moreover, McBride actually teaches away from a restore interface. McBride simply teaches, "to restore a file..., the user simply inserts the mirror disk into the removable media drive and selects the highest numerical revision of the file...The file can be simply copied back to the source folder or other folder and/or drive for immediate use." [McBride, col. 12, lines 10-15] McBride also teaches, "an advantage of the present invention over conventional backup utilities is that a separate restore operation is not necessary to restore the most recent version of a file." [McBride, col. 12, lines 1-3] **Therefore, McBride specifically teaches his invention overcomes the need for a separate restore operation since restore is possible by inserting a disk into a removable media drive.** If McBride overcomes the need for a separate restore application, then McBride cannot be properly combined with a reference that teaches a separate restore application. That is exactly what McBride is overcoming. Accordingly, it is improper to combine a reference where it teaches away from such a combination, and McBride clearly teaches away from any combination with a restore information interface. For further emphasis of this point, the MPEP teaches "[i]t is improper to combine references where the references teach away from their combination." (MPEP 2145 X.D.2)

In other words, McBride teaches that a backup source of information is put onto the device using conventional file manipulation techniques or by inserting a disk and NOT using a restore information interface.

3. Jewell does not teach a restore interface on a wireless phone.

Jewell is a regular application with a filing date of December 6, 2004, which is after the filing date of the above-titled application with a filing date of February 27, 2004. While Jewell is based on a provisional, U.S. Provisional Patent App. No. 60/526,610, with a filing date of December 4, 2003, under 35 U.S.C. 102(e) and 35 U.S.C. 119(e), only that which is disclosed in the provisional is entitled to the earlier filing date, and any newly added material is awarded the filing date of when that new material is filed. In the provisional of the Jewell application, there is no teaching of a telephone or a wireless telephone. It is only in the regular application, where Jewell includes a blanket paragraph in an attempt to cover many different computing devices including a “wireless communication device” which still is not necessarily a “telephone” as is claimed in the present application. Therefore, it is not until after the present application was filed, that Jewell disclosed a “wireless communication device.” Thus, the Jewell provisional application only teaches a backup and restore system for workstations and servers and only that can be cited against the present application. One point of novelty of the present invention includes a backup user account set-up interface, a backup scheduling interface and a restore information interface on a phone. A restore system for workstations and servers is significantly different than a restore interface for a wireless phone. Therefore, Jewell does not teach a restore interface for a telephone or a wireless communication device until after the filing date of the present invention.

4. The combination of McBride and Jewell is improper, and even if proper, does not teach a restore interface on a wireless phone.

In contrast to the teachings of McBride, Jewell and their combination, the present invention is directed towards a user interface for backing up and restoring data on a user's phone. As described above, McBride does not teach a restore interface and teaches a method of restoring which only utilizes a removable media such as a Zip disk. McBride teaches away from any sort of restore interface since the restore interface is unnecessary when using a removable media to restore the information. Therefore, it is improper to combine any references teaching a restore interface with McBride since McBride specifically indicates that the implementation with a removable media is better and needs no additional restore operations. Furthermore, the

provisional application of Jewell does not teach a backup and restore system for a phone. Therefore, the restore of Jewell which is directed towards restoring data on workstations and servers is not properly combined with McBride. More specifically, one would have had no motivation to combine the backup system of McBride with the restore system for workstations and servers of Jewell to produce the claimed invention of a backup user account set-up interface, a backup scheduling interface and a restore information interface on a phone. **Moreover, because McBride teaches away from a restore interface and Jewell fails to teach a telephone or wireless communication device, even combining these references cannot teach the claimed invention.**

In comparison, with regards to teaching away, the court in In re OMEPRAZOLE PATENT LITIGATION, 490 F.Supp.2d 381 (S.D.N.Y. 2007) held that the cited references taught away from the claimed invention because the claimed invention was intended to deliver drugs to the intestines after passing through the stomach while one of the references delivered its active ingredient to the stomach. Similarly, the Present Invention intends to back up and restore data using an account set-up interface, a backup scheduling interface and a restore information interface on the wireless phone, but the cited reference, McBride, teaches overcoming the need for a restore operation and a restore interface on a wireless phone by the use of restoring to a removable media device without the need for a restore interface. Therefore, as the court in OMEPRAZOLE found the cited references to teach away from the claimed invention, the same should be found here in reference to McBride.

Furthermore, impermissible hindsight has been used to combine McBride and Jewell. There is no teaching, hint, suggestion or motivation to combine the teachings of McBride with Jewell, as demonstrated by the fact that no teaching, hint, suggestion or motivation is cited within the Office Action of January 10, 2008. As discussed above, McBride relates to a data file mirroring application that monitors data files stored in a source directory for archiving and restoring the data to a removable media device such as a Zip disk. Jewell is directed to a restore system for workstations and servers and not wireless phones.

This is a classic case of impermissibly using hindsight to make a rejection based on obviousness. The Court of Appeals for the Federal Circuit has stated that “it is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” In Re Fritch, 972 F.2d, 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). As discussed above, McBride teaches a backup

system which restores data to a removable media device and specifically states that no other restore operation is necessary. Since the restore is to a removable media device, a restore interface is not necessary. All that occurs is a simple copy from one location to a Zip disk. Jewell is directed to a restore system specifically for workstations and servers which have very little in common with wireless phones, particularly wireless phones known at the time of the invention. There is no hint, teaching or suggestion to warrant their combination. As discussed above, Jewell is not directed to a wireless phone. Further, neither McBride, Jewell nor their combination teach or make obvious a restore interface on a wireless phone. To conclude that this is obvious based on the teachings of these references is to use hindsight based on the teachings of the present invention and to read much more into McBride and Jewell than their actual teachings. This is simply not permissible based on the directive from the Court of Appeals for the Federal Circuit. While the Supreme Court in KSR Int'l Co. v. Teleflex Inc. et al., 127 S. Ct. 1727 (2007) provided flexibility to the Teaching/Suggestion/Motivation Test ("TSM Test"), KSR did not nullify the TSM Test. The TSM Test was further upheld by the court in Global Traffic Technologies LLC v. Tomar Electronics, Inc., 2007 WL 4591297 (D.Minn.). With the requirements of the TSM Test still intact, there is simply no teaching, hint, suggestion or motivation known at the time of the invention without using the present invention as a template to combine the backup system using Zip disks of McBride with the restore system specifically designed for workstations and servers of Jewell. Therefore, this provides an additional reason why the combination of McBride and Jewell is improper.

5. The claims distinguish over McBride, Jewell and their combination.

The claims are grouped separately below to indicate that they do not stand or fall together.

a. Claims 1-5 and 14-17

The independent Claim 1 is directed to a method implemented by a processing device on a wireless telephone for backing up personal information stored in the wireless telephone. The method of Claim 1 comprises presenting a back-up system user account set-up interface on a user interface on the wireless phone, the set-up interface enabling establishment of a back-up service account, and the set-up interface including a display, one or more alphanumerical buttons and one or more soft buttons, different than the alphanumerical buttons, on the wireless phone, the function of the one or more soft buttons on the wireless phone changing, under control of a software application agent on the wireless phone, depending on the content displayed on the

display screen, presenting a backup scheduling interface on the wireless phone, the backup scheduling interface accepting user input on a backup schedule, and the backup scheduling interface including a display, one or more alphanumerical buttons and one or more soft buttons, different than the alphanumerical buttons, on the wireless phone, the function of the one or more soft buttons on the wireless phone changing, under control of a software application agent on the wireless phone, depending on the content displayed on the display screen and presenting a restore information interface on the wireless phone, the restore interface enabling a user to retrieve backup information to a data store on the wireless phone, and the restore information interface including a display, one or more alphanumerical buttons and one or more soft buttons, different than the alphanumerical buttons, on the wireless phone, the function of the one or more soft buttons on the wireless phone changing, under control of a software application agent on the wireless phone, depending on the content displayed on the display screen. As described above, the combination of McBride and Jewell is improper because McBride teaches away from any combination of a restore interface, and there is no motivation to combine the provisional application of Jewell with McBride since Jewell is solely directed towards backup and restore for workstations and servers, not phones. For at least these reasons, the independent Claim 1 is allowable over the teachings of McBride, Jewell and their combination.

Claims 2-5 and 14-17 are dependent upon the independent claim 1. As discussed above, the independent claim 1 is allowable over the teachings of McBride, Jewell and their combination. Accordingly, claims 2-5 and 14-17 are also allowable as being dependent upon an allowable base claim.

b. Claims 20-29

The independent Claim 20 is directed to a method of storing personal information in a wireless telephone in a backup storage database. The method of Claim 20 comprises providing a phone agent including instructions operable by a processor in the phone to implement an automated phone data transmission method capable of regularly transmitting changes to a backup store via a communications link, and a restore method retrieving backup information to a data store on the phone, the agent including a backup service sign-up interface, a backup method scheduling interface and a restore interface, calling the restore method, all provided to a user interface on the phone, the user interface on the phone including a display and one or more buttons on the phone and responsive to user entry at the restore interface of said agent, providing changes from the backup store to the wireless telephone. As described above, the combination of McBride and Jewell is improper because McBride teaches away from any combination of a restore interface, and there is no motivation to combine the provisional application of Jewell with

McBride since Jewell is solely directed towards backup and restore for workstations and servers, not phones. For at least these reasons, the independent Claim 20 is allowable over the teachings of McBride, Jewell and their combination.

Claims 21-29 are dependent upon the independent claim 20. As discussed above, the independent claim 20 is allowable over the teachings of McBride, Jewell and their combination. Accordingly, claims 21-29 are also allowable as being dependent upon an allowable base claim.

c. Claims 52 and 56-60

The independent Claim 52 is directed to an application for storing personal information in a wireless telephone having a user interface and having a data store, to a backup system. The application of Claim 52 comprises an automated user account creation method initiated by the user via a user interface on a wireless telephone, the creation method accessing the backup system using a unique identifier for the user to create a user account on the backup system, an automated backup method transmitting changes to the backup system at user defined intervals and a restore method called by the user through a restore interface presented on the user interface of the phone, the restore method providing user data to a phone. As described above, the combination of McBride and Jewell is improper because McBride teaches away from any combination of a restore interface, and there is no motivation to combine the provisional application of Jewell with McBride since Jewell is solely directed towards backup and restore for workstations and servers, not phones. For at least these reasons, the independent Claim 52 is allowable over the teachings of McBride, Jewell and their combination.

Claims 55-60 are dependent upon the independent claim 52. As discussed above, the independent claim 52 is allowable over the teachings of McBride, Jewell and their combination. Accordingly, claims 55-60 are also allowable as being dependent upon an allowable base claim.

d. Claims 82-86

The independent Claim 82 is directed to a user interface implemented by a processing device on a telephone for backing up personal information stored in the wireless telephone, comprises an account set-up interface on the wireless phone enabling establishment of a back-up service account, a scheduling interface on the wireless phone allowing a user to manually set up a schedule for backing up data on the wireless phone, the scheduling interface including: a display on the wireless phone, alphanumeric buttons on the wireless phone, soft buttons on the wireless phone, different than the alphanumeric buttons, the function of the soft buttons changing depending on what is displayed on the display, and a software application agent on the wireless

phone for: 1) controlling what is displayed on the display, 2) controlling the function of the soft buttons, and 3) setting up a back-up schedule when information is sent to a back-up store based on information manually entered into the scheduling interface and a restore information interface enabling a user to retrieve backup information to a data store on the wireless phone. As described above, the combination of McBride and Jewell is improper because McBride teaches away from any combination of a restore interface, and there is no motivation to combine the provisional application of Jewell with McBride since Jewell is solely directed towards backup and restore for workstations and servers, not phones. For at least these reasons, the independent Claim 82 is allowable over the teachings of McBride, Jewell and their combination.

Claims 83-86 are dependent upon the independent claim 82. As discussed above, the independent claim 82 is allowable over the teachings of McBride, Jewell and their combination. Accordingly, claims 83-86 are also allowable as being dependent upon an allowable base claim.

e. Claim 92

The independent Claim 92 is directed to a user interface implemented by a processing device on a wireless telephone for backing up personal information stored in the wireless telephone. The user interface of Claim 92 comprises an account-setup interface on the wireless phone enabling establishment of a back-up service account, a scheduling interface on the wireless phone allowing a user to manually set up a schedule for backing up data on the wireless phone, a restore information interface enabling a user to retrieve backup information to a data store on the wireless phone, one or more of the account-setup interface, the scheduling interface and the restore information interface including a display on the wireless phone, alphanumeric buttons on the wireless phone, soft buttons on the wireless phone, different than the alphanumeric buttons, the function of the soft buttons changing depending on what is displayed on the display, and a software application agent on the wireless phone for controlling what is displayed on the display and variably setting the function of the soft buttons. As described above, the combination of McBride and Jewell is improper because McBride teaches away from any combination of a restore interface, and there is no motivation to combine the provisional application of Jewell with McBride since Jewell is solely directed towards backup and restore for workstations and servers, not phones. For at least these reasons, the independent Claim 92 is allowable over the teachings of McBride, Jewell and their combination.

f. Claim 93

The independent Claim 93 is directed to a user interface implemented by a processing device on a wireless telephone for backing up personal information stored in the wireless telephone. The user interface of Claim 93 comprises an account-setup interface on the wireless phone enabling establishment of a back-up service account, a scheduling interface on the wireless phone allowing a user to manually set up a schedule for backing up data on the wireless phone, and a restore information interface enabling a user to retrieve backup information to a data store on the wireless phone, one or more of the account-setup interface, the scheduling interface and the restore information interface including a display on the wireless phone, the display displaying one or more of words and icons, a user interacting with the user interface by selecting one or more of the words and icons on the display, and a software application agent on the wireless phone for controlling what is displayed on the display and controlling backup of personal information based on the selection of one or more words and icons on the display. As described above, the combination of McBride and Jewell is improper because McBride teaches away from any combination of a restore interface, and there is no motivation to combine the provisional application of Jewell with McBride since Jewell is solely directed towards backup and restore for workstations and servers, not phones. For at least these reasons, the independent Claim 93 is allowable over the teachings of McBride, Jewell and their combination.

Grounds for Rejection

Within the Office Action, Claims 6-13, 53, 54 and 87-89 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over McBride and Jewell further in view of Griffin.

Claims 6-13 are dependent upon the independent claim 1. As discussed above, the independent claim 1 is allowable over the teachings of McBride, Jewell and their combination. Accordingly, claims 6-13 are also allowable as being dependent upon an allowable base claim.

Claims 53 and 54 are dependent upon the independent claim 52. As discussed above, the independent claim 52 is allowable over the teachings of McBride, Jewell and their combination. Accordingly, claims 53 and 54 are also allowable as being dependent upon an allowable base claim.

Claims 87-89 are dependent upon the independent claim 82. As discussed above, the independent claim 82 is allowable over the teachings of McBride, Jewell and their combination. Accordingly, claims 87-89 are also allowable as being dependent upon an allowable base claim.

Grounds for Rejection

Within the Office Action, Claims 18, 19, 90 and 91 have been rejected under 35 U.S.C. §103(a) as being unpatentable over McBride and Jewell in view of Sugimoto.

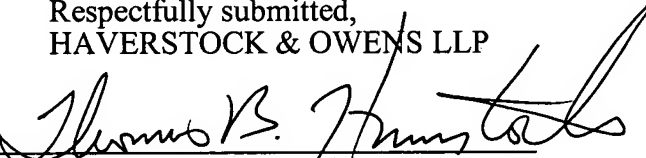
Claims 18 and 19 are dependent upon the independent claim 1. As discussed above, the independent claim 1 is allowable over the teachings of McBride, Jewell and their combination. Accordingly, claims 18 and 19 are also allowable as being dependent upon an allowable base claim.

Claims 90 and 91 are dependent upon the independent claim 82. As discussed above, the independent claim 82 is allowable over the teachings of McBride, Jewell and their combination. Accordingly, claims 90 and 91 are also allowable as being dependent upon an allowable base claim.

6. CONCLUSION

For the above reasons, it is respectfully submitted that the Claims 1-29, 52-60 and 82-93 are allowable over the cited prior art references. Therefore, a favorable indication is respectfully requested.

Dated: 3-14-08

Respectfully submitted,
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VIII. CLAIMS APPENDIX

This appendix includes a list of the claims under appeal.

1. A method implemented by a processing device on a wireless telephone for backing up personal information stored in the wireless telephone, comprising:

presenting a back-up system user account set-up interface on a user interface on the wireless phone, the set-up interface enabling establishment of a back-up service account, and the set-up interface including a display, one or more alphanumerical buttons and one or more soft buttons, different than the alphanumerical buttons, on the wireless phone, the function of the one or more soft buttons on the wireless phone changing, under control of a software application agent on the wireless phone, depending on the content displayed on the display screen;

presenting a backup scheduling interface to the user interface on the wireless phone, the backup scheduling interface accepting user input on a backup schedule, and the backup scheduling interface including a display, one or more alphanumerical buttons and one or more soft buttons, different than the alphanumerical buttons, on the wireless phone, the function of the one or more soft buttons on the wireless phone changing, under control of a software application agent on the wireless phone, depending on the content displayed on the display screen; and

presenting a restore information interface on the user interface on the wireless phone, the restore interface enabling a user to retrieve backup information to a data store on the wireless phone, and the restore information interface including a display, one or more alphanumerical buttons and one or more soft buttons, different than the alphanumerical buttons, on the wireless phone, the function of the one or more soft buttons on the wireless phone changing, under control of a software application agent on the wireless phone, depending on the content displayed on the display screen.

2. The method of claim 1 wherein the user account setup interface calls a method allowing the user to set up a backup account with a backup store.

3. The method of claim 1 wherein the backup scheduling interface sets an interval to regularly send personal information to the backup store.

4. The method of claim 1 wherein the backup scheduling interface causes the transmission of personal information to the backup store upon modification of the information on the phone.

5. The method of claim 1 wherein the restore interface calls a method to upload all stored

information on a backup data store to the data store on the phone.

6. The method of claim 5 wherein the method further includes providing a rollback interface to the user interface on the phone.
7. The method of claim 6 wherein the rollback interface is accessed via a web browser.
8. The method of claim 6 where the rollback interface is accessed via a wireless protocol.
9. The method of claim 6 wherein the rollback interface calls a method uploading changes based on a particular date
10. The method of claim 1 wherein the method further includes providing an undelete interface.
11. The method of claim 10 wherein the undelete interface is accessed via a web browser.
12. The method of claim 10 wherein the undelete interface is accessed via a wireless protocol such as WAP.
13. The method of claim 10 wherein the undelete interface calls a method which transmits a change associated with a particular record in a user's personal information space.
14. The method of claim 1 wherein said personal information comprises an address book data store.
15. The method of claim 1 wherein said personal information comprises a task entry data store.
16. The method of claim 1 wherein said personal information comprises a calendar entry data store.
17. The method of claim 1 wherein said personal information comprises a note entry data store.
18. The method of claim 1 wherein said personal information comprises an alarm data store.

19. The method of claim 1 wherein said personal information comprises a custom dictionary data store.
20. A method for storing personal information in a wireless telephone in a backup storage database, comprising:
providing a phone agent including instructions operable by a processor in the phone to implement an automated phone data transmission method capable of regularly transmitting changes to a backup store via a communications link, and a restore method retrieving backup information to a data store on the phone, the agent including a backup service sign-up interface, a backup method scheduling interface and a restore interface, calling the restore method, all provided to a user interface on the phone, the user interface on the phone including a display and one or more buttons on the phone; and
responsive to user entry at the restore interface of said agent, providing changes from the backup store to the wireless telephone.
21. The method of claim 20 wherein the method further includes accepting personal information from the telephone at intervals defined by the user defined by the user via the backup method scheduling interface.
22. The method of claim 20 wherein the method further includes accepting user account set-up data from the service sign-up interface of the agent.
23. The method of claim 20 wherein the method further includes assigning a schedule of download intervals to the agent.
24. The method of claim 21 wherein the method further includes modifying the interval schedule to load balance amongst a plurality of users.
25. The method of claim 20 further including providing a notification to the agent that changes have been made to the backup store via a secondary interface.
26. The method of claim 25 wherein the phone agent updates the data store on phone upon receipt of a notification.
27. The method of claim 25 wherein the notification is a SMS message.

28. The method of claim 20 wherein the notification is a result of polling the server for changes.

29. The method of claim 25 wherein the method further includes providing the secondary interface and the secondary interface is a web interface.

30 - 51. (canceled)

52. An application for storing personal information in a wireless telephone having a user interface and having a data store, to a backup system, comprising:

an automated user account creation method initiated by a user via a user interface on a wireless telephone, the creation method accessing the backup system using a unique identifier for the user to create a user account on the backup system;

an automated backup method transmitting changes to the backup system at user defined intervals; and

a restore method called by the user through a restore interface presented on the user interface of the phone, the restore method providing user data to a phone.

53. The application of claim 52 wherein the application includes a rollback method providing a state of user data existing as of a specified date.

54. The application of claim 52 wherein the application includes an undelete method providing at least one restored data item previously deleted by a user action.

55. The application of claim 52 wherein at least the backup method and the account creation method are initiated by the agent.

56. The application of claim 52 wherein the intervals are defined by user but altered by administrator.

57. The application of claim 52 wherein the intervals are regular.

58. The application of claim 52 wherein the intervals are arbitrary.

59. The application of claim 52 wherein the restore method operates responsive to a phone recognized as having no data and an existing user account.

60. The application of claim 52 wherein the account creation method is performed by the backup system via a secondary interface provided to the user.

61 - 81. (canceled)

82. A user interface implemented by a processing device on a telephone for backing up personal information stored in the wireless telephone, comprising:

- an account set-up interface on the wireless phone enabling establishment of a back-up service account;

- a scheduling interface on the wireless phone allowing a user to manually set up a schedule for backing up data on the wireless phone, the scheduling interface including:

- a display on the wireless phone,

- alphanumeric buttons on the wireless phone,

- soft buttons on the wireless phone, different than the alphanumeric buttons, the function of the soft buttons changing depending on what is displayed on the display, and

- a software application agent on the wireless phone for: 1) controlling what is displayed on the display, 2) controlling the function of the soft buttons, and 3) setting up a back-up schedule when information is sent to a back-up store based on information manually entered into the scheduling interface; and

- a restore information interface enabling a user to retrieve backup information to a data store on the wireless phone.

83. The user interface of claim 82 wherein the backup scheduling interface causes the transmission of personal information to the backup store upon modification of the information on the phone.

84. The user interface of claim 82 wherein the restore interface calls a method to upload all stored information on a backup data store to the data store on the phone.

85. The user interface of claim 84 wherein the user interface further includes a rollback interface which returns data on the phone to a state existing on a specified date.

86. The user interface of claim 82 wherein said information comprises an address book data store.

87. The user interface of claim 82 wherein said information comprises a task entry data store.

88. The user interface of claim 82 wherein said information comprises a calendar entry data store.
89. The user interface of claim 82 wherein said information comprises a note entry data store.
90. The user interface of claim 82 wherein said information comprises an alarm data store.
91. The user interface of claim 82 wherein said personal information comprises a custom dictionary data store.
92. A user interface implemented by a processing device on a wireless telephone for backing up personal information stored in the wireless telephone, comprising:
an account set-up interface on the wireless phone enabling establishment of a back-up service account;
a scheduling interface on the wireless phone allowing a user to manually set up a schedule for backing up data on the wireless phone;
a restore information interface enabling a user to retrieve backup information to a data store on the wireless phone, one or more of the account-setup interface, scheduling interface and the restore information interface including:
a display on the wireless phone,
alphanumeric buttons on the wireless phone,
soft buttons on the wireless phone, different than the alphanumeric buttons, the function of the soft buttons changing depending on what is displayed on the display, and
a software application agent on the wireless phone for: 1) controlling what is displayed on the display, and 2) variably setting the function of the soft buttons.
93. A user interface implemented by a processing device on a wireless telephone for backing up personal information stored in the wireless telephone, comprising:
an account set-up interface on the wireless phone enabling establishment of a back-up service account;
a scheduling interface on the wireless phone allowing a user to manually set up a schedule for backing up data on the wireless phone; and
a restore information interface enabling a user to retrieve backup information to a data store on the wireless phone;
one or more of the account-setup interface, scheduling interface and the restore information interface including a display on the wireless phone, the display displaying one or

more of words and icons, a user interacting with the user interface by selecting one or more of the words and icons on the display; and

a software application agent on the wireless phone for: 1) controlling what is displayed on the display, and 2) controlling backup of personal information based on the selection of one or more of the words and icons on the display.

IX. EVIDENCE APPENDIX

STATEMENT

Pursuant to 37 C.F.R. § 41.37(c)(1)(ix), the following is a statement setting forth where in the record the evidence of this appendix was entered by the examiner:

Evidence Description:	Where Entered:
U.S. Pat. No. 6,757,698	Office Action mailed August 10, 2007
U.S. Pat. Publ. No. 2005/0131990	Office Action mailed August 10, 2007
U.S. Pat. No. 6,396,482	Office Action mailed August 10, 2007
U.S. Pat. Publ. No. 2004/0192260	Office Action mailed January 30, 2007
Office Action January 10, 2008	Examiner Office Action

X. RELATED PROCEEDINGS APPENDIX

There are no related proceedings.